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PATENT APPLICATION

Attorney Docket No: 10019417-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Hamilton et al.

Serial No: 09/942,503

Filing Date: 08/29/2001

Title: Acquisition and Organization of Digital Images

Confirmation No.: 8040

Examiner: Worku, Negussie

Group Art Unit: 2625

Mail Stop Appeal Brief - Patents
Commissioner for Patents
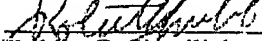P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF (SUBSTITUTE)

Sir:

Transmitted herewith is the Appeal Brief (Substitute) in this application with respect to the Notice of Appeal filed on **03/15/2007** and the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed on **06/25/2007**.
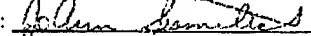
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Respectfully Submitted,
Hamilton et al.

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HP Docket No. 10019417-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	: 09/942,503	)
Conf. No.	: 8040	)
Appellant	: Hamilton et al.	)
Filed	: 08/29/2001	)
Title	: Acquisition and Organization of Digital Images	)
		)
		)
TC / Art Unit	: 2625	)
Examiner	: Worku, Negussie	)
		)
Docket No.	: 10019417-1	)
Customer No.	: 022879	)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPELLANTS' APPEAL BRIEF (SUBSTITUTE)

Sir:

Appellants are appealing from the Final Rejection of claims 1-9, 11-25, 27-38, and 41 in a Non-Final Office Action dated 12/15/2006. Prosecution was reopened following submission of Appellants' prior Appeal Brief. The Appeal is reinstated in accordance with MPEP § 1204.01. This Substitute Appeal Brief is filed in response to the Notification of Non-Compliant Appeal Brief mailed 06/25/2007.

I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a

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Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the real party in interest which will directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-9, 11-25, 27-38, and 41 are pending. All of claims 1-9, 11-25, 27-38, and 41 stand rejected. The Appellants appeal the rejection of claims 1-9, 11-25, 27-38, and 41.

IV. STATUS OF AMENDMENTS

The most recent Office Action, dated 12/15/2006, reopening prosecution following submission of Appellants' prior Appeal Brief is a Non-Final Office Action. Accordingly, since the application is not under final rejection, no amendments subsequent to final rejection have been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 1, 11, 27, 35-38, and 41 are under appeal. The claimed subject matter relates to an image processing system.

Independent claim 1 recites a method of optically scanning a target item. In one embodiment, and with reference to Fig. 1, the method may be performed by an image processing system 10. In system 10, an image capture subsystem 30 may acquire digital

image data from an image source 20, such as an optical scanner 24 (Fig. 2), or a multifunction printer 25 (Fig. 2) that includes an optical scanner subsystem (p.3, line 21 – p.4, line 1; p.5, lines 2-7). In operation according to the method, and with reference to Figs. 4 and 6, at 102 the digital image data is acquired from the image source 20 (p.11, lines 2-4). As part of the acquisition process 102, the digital image data is captured 126 or preprocessed 132 according to predefined settings for scanning parameters, such as exemplary parameters 140 (Fig. 7), that are appropriate to a photographic image (p.14, lines 2-16). Such predefined settings appropriate to a photographic image may include, for example, a pixel depth 142 of 24-bit color; an image resolution 144 of 150 dots per inch (dpi); a crop mode 146 of automatic border detection; and a skew correction mode 148 of automatic image straightening (p.15, lines 3-12). However, these predefined settings are not defined by the user of the image processing system 10 (p.15, lines 12-18). After the digital image data has been acquired 102, the digital image data is converted 106 into a data file and stored 108 on a file system 40, automatically and without intervention by a user (p.11, lines 9-11). For image sources such as the optical scanner 24 or multifunction printer 25, digital image data can advantageously be acquired more quickly and easily than in previous systems, because there is no need for the user to determine and manually adjust the scanning parameter settings in conjunction with a preview of the captured image before the digital image data is acquired (p.15, lines 12-18).

Independent claim 36 recites a processor-readable medium having processor-executable instructions thereon which, when executed by a processor, cause the processor to operate in a manner similar to as has been described with regard to claim 1. In operation according to the instructions, and with reference to Figs. 4 and 6, at 102 the digital image data is acquired from the image source 20 (p.11, lines 2-4). As part of the acquisition process 102, the digital image data is captured 126 or preprocessed 132 according to predefined settings for scanning parameters, such as exemplary parameters 140 (Fig. 7), that are appropriate to a photographic image (p.14, lines 2-16). These predefined settings are not defined by the user of the image processing system 10 (p.15, lines 12-18). After the digital image data has been acquired 102, the digital image data is converted 106 into a data file and stored 108 on a file system 40, automatically and without intervention by a user (p.11, lines 9-11). There is no

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need for the user to determine and manually adjust the scanning parameter settings in conjunction with a preview of the captured image before the digital image data is acquired (p.15, lines 12-18).

Independent claim 38 recites an image processing system. In this embodiment, the system includes a means for configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image and that are not defined by the user. The structure corresponding to the configuring means is image capture subsystem 30 (Fig. 1; p.6, lines 15-17). The system also includes a means for initiating a scanning operation. The structure corresponding to the initiating means is image management subsystem 50 (Fig. 1; p.8, lines 11-18) or an external signal provided to image source 20a (Fig. 1; p.9, lines 1-5). The system also includes a means for optically scanning the target item automatically without intervention by a user. The structure corresponding to the scanning means is image source 20a and image capture subsystem 30 (p.6, line 9 – p.7, line 8). The system also includes a means for converting the digital image into a data file automatically without intervention by a user. The structure corresponding to the converting means is image capture subsystem 30 (p.9, lines 9-11).

Independent claims 27 and 41 also recite an image processing system. In these embodiments, the system includes at least one image source 20 that provides at least one digital image upon request to do so (p.6, lines 10-11). In some embodiments, a date may be associated with the digital image data. In one embodiment in which the digital image data is from a "prerecorded" image source 20b, such as a memory card in a digital camera 21a (Fig. 2), the date may be the date on which the image data was recorded by the source 20b. In another embodiment in which the digital image data is from a "live" image source 20a, such as the optical scanner 24, the date may be the current date on which the scanning is performed, and which can be provided to the image capture subsystem 30 from a date subsystem 32 (p.6, line 21 – p.7, line 14). An image capture subsystem 30 coupled to the at least one image source 20 requests and receives the digital image from the image source 20 (p.6, lines 10-11). In addition, the image capture subsystem 30 further associates 104 a date with each digital image, and automatically converts each digital image into a corresponding

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image file (p.9, lines 9-13). A file system 40 coupled to the image capture subsystem 30 automatically stores each image file in a selected one of a plurality of data folders such as folders 42a,42b (Fig. 3; p.11, lines 10-20). The selected data folder has a folder name that is indicative of the date that is associated with the digital image. In some embodiments, the folder name may be indicative of a particular month and year. For example, the exemplary computer monitor display view 60 illustrates data folders 42a-b in a folder window 62, and thumbnail views of image files 64a-b in a file window 66 (Fig. 3; p.7, line 18 – p.8, line 5). Data folder 42a has the folder name of "Jul 2001", indicative of the month and year of July, 2001. Similarly, data folder 42b has the folder name of "Aug 2001", indicative of the month and year of August, 2001. In operation, if a date of July 15, 2001 is associated with an acquired digital image, then the digital image data file will be stored into folder 42a, which has the folder name of "Jul 2001". If a date of August 23, 2001 is associated with an acquired digital image, then the digital image data file will be stored into folder 42b, which has the folder name of "Aug 2001". If no folder 42 having a folder name indicative of the date as yet exists, such a folder 42 will be created as needed (p.11, lines 10-20). This folder naming and image storing scheme advantageously organizes the digital images by date, thus allowing the user to easily and quickly locate desired images for viewing or post-processing.

Independent claim 11 recites a method that is similar to operations performable by the system of claim 27. A digital image is acquired from an image source (Fig. 4, step 102; p.11, lines 2-3). A date is automatically associated with the digital image (Fig. 4, step 104; p.11, line 5). The digital image is automatically converted into a data file (Fig. 4, step 1062; p.11, line 9). The data file is stored into a folder of a file system 40 (Fig. 1), the folder having a folder name indicative of the date (Fig. 4, step 108; p.11, lines 10-18). The folder name is indicative of the date that is associated with the digital image. In some embodiments, the folder name may be indicative of a particular month and year. For example, the exemplary computer monitor display view 60 illustrates data folders 42a-b in a folder window 62, and thumbnail views of image files 64a-b in a file window 66 (Fig. 3; p.7, line 18 – p.8, line 5; p.11, lines 10-20). Data folder 42a has the folder name of "Jul 2001", indicative of the month and year of July, 2001. Similarly, data folder 42b has the folder name of "Aug 2001",

indicative of the month and year of August, 2001. In operation, if a date of July 15, 2001 is associated with an acquired digital image, then the digital image data file will be stored into folder 42a, which has the folder name of "Jul 2001". If a date of August 23, 2001 is associated with an acquired digital image, then the digital image data file will be stored into folder 42b, which has the folder name of "Aug 2001". If no folder 42 having a folder name indicative of the date as yet exists, such a folder 42 will be created as needed (p.11, lines 10-20). This folder naming and image storing scheme advantageously organizes the digital images by date, thus allowing the user to easily and quickly locate desired images for viewing or post-processing.

Independent claim 35 recites a processor-readable medium having processor-executable instructions thereon which, when executed by a processor of a system, cause the processor to operate in a manner similar to as has been described with regard to claim 11. A digital image is acquired from an image source (Fig. 4, stcp 102; p.11, lines 2-3). The digital image is automatically converted into a data file (Fig. 4, step 106; p.11, line 9). The data file is stored into a folder of a file system 40 (Fig. 1), the folder having a folder name indicative of the date (Fig. 4, step 108; p.11, lines 10-18). The folder name is indicative of the date that is associated with the digital image. In some embodiments, the folder name may be indicative of a particular month and year. For example, the exemplary computer monitor display view 60 illustrates data folders 42a-b in a folder window 62, and thumbnail views of image files 64a-b in a file window 66 (Fig. 3; p.7, line 18 – p.8, line 5; p.11, lines 10-20). Data folder 42a has the folder name of "Jul 2001", indicative of the month and year of July, 2001. Similarly, data folder 42b has the folder name of "Aug 2001", indicative of the month and year of August, 2001. In operation, if a date of July 15, 2001 is associated with an acquired digital image, then the digital image data file will be stored into folder 42a, which has the folder name of "Jul 2001". If a date of August 23, 2001 is associated with an acquired digital image, then the digital image data file will be stored into folder 42b, which has the folder name of "Aug 2001". This folder naming and image storing scheme advantageously organizes the digital images by date, thus allowing the user to easily and quickly locate desired images for viewing or post-processing.

Independent claim 37 recites an image processing system. In this embodiment, the system includes a means for acquiring a digital image from an image source 20. The structure corresponding to the acquiring means is image capture subsystem 30 (Fig. 1; p.6, lines 15-17). The system also includes a means for automatically converting the digital image into a data file having a date associated with the digital image. The structure corresponding to the converting means is image capture subsystem 30 (Fig. 1; p.9, lines 9-13). The system also includes a means for storing the data file into a data folder of a file system, where the folder has a folder name indicative of the date. The structure corresponding to the storing means is image capture subsystem 30 (Fig. 1; p.7, line 12 – p.8, line 3; p.11, lines 10-20).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-9, 11-25, 27-38, and 41 have been rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. patent 7,113,306 to Nakabayashi ("Nakabayashi").

Claims 11-14, 16-25, 27-35, 37, and 41 stand or fall together.

Claim 15 stands or falls alone.

Claims 1-3, 6-9, 36, and 38 stand or fall together.

Claim 4 stands or falls alone.

Claim 5 stands or falls alone.

VII. ARGUMENT

A. <u>Claims 11-14, 16-25, 27-35, 37, and 41 were improperly rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. patent 7,113,306 to Nakabayashi ("Nakabayashi").</u>

As to a rejection under §102, "[a]nticipation is established only when a single prior art

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reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.Q. 385.* The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).* The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).* The elements must be arranged as required by the claim. *In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).*

Appellants contend that claims 11-14, 16-25, 27-35, 37, and 41 were improperly rejected because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

1. The Nakabayashi reference does not disclose all the limitations of Appellants' independent claim 11 in that the limitation of "storing the data file into a folder of a file system, the folder having a folder name indicative of the date" is absent from the reference.

The rejection of independent claim 11, and its dependent claims 12-14 and 16-25, is respectfully traversed for at least the following reasons. Independent claim 11 recites:

"11. A method of automatically organizing digital images, comprising:
acquiring a digital image from an image source;
automatically associating a date with the digital image;
automatically converting the digital image into a data file; and
storing the data file into a folder of a file system, the folder having a folder name
indicative of the date." (emphasis added)

The Nakabayashi reference is directed to a system in which "Image data are housed in a folder managed as a film metaphor" (Abstract). The Examiner contends that the Nakabayashi reference discloses "storing the data file into a folder of a file system, (folder system of fig 5 and 6) the folder associated with the date (col. 13, lines 40-50)" (Office

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Action, p.6; emphasis added). Appellants respectfully disagree.

First, the Examiner mischaracterizes the limitation at issue. Appellants do not claim that the folder is associated with the date. Claim 11 recites that the folder has a folder name that is indicative of a date that is associated with the digital image. Even if, arguendo, and which Appellants do not concede, the Nakabayashi reference were to teach that the folder into which a digital image data file is stored is associated with a date associated with a digital image, this is significantly different from the recited limitation in which the folder has a folder name that is indicative of a date associated with the digital image.

But furthermore, the Nakabayashi reference does not teach the limitation of storing the data file into a folder of a file system, the folder having a folder name indicative of the date. With regard to this limitation, it can be appreciated in Fig. 3 of the present application that, for example, folder 42a has a folder name of "Jul 2001", and that folder 42b has a folder name of "Aug 2001". Such folder names are indicative of a date associated with the digital image. As explained with reference to Figs. 3 and 4 of the present application:

"At 108, the data file is stored into a data folder, such as folder 42, of a file system 40. The folder 42 is associated with the date, and typically selected from a set of data folders. If no folder 42 associated with the date as yet exists on the file system 40, such a folder 42 is created. In the preferred embodiment, the data folder is associated with a particular month and year, such as folder 42a for July 2001 and folder 42b for August 2001. For example, for a particular digital image that has a capture date of Jul. 15, 2001 and a storage date of Aug. 23, 2001, if the associated date is the capture date, the image file will be stored into the July 2001 folder 42a, alternatively, if the associated date is the storage date, the image file will be stored into the August 2001 folder 42b. Such a folder organization advantageously organizes the digital images by date, thus helping the user to easily and quickly locate desired images for viewing or post-processing." (p.11, lines 10-20)

Conversely, the Nakabayashi reference discloses a folder organization in which the folder names are not indicative of a date associated with the digital image. The folder system of Fig. 6 cited by the Examiner illustrates 3 folders (in the leftmost "file" column), but does not specify the names of the folders, which are denoted only as "Folder". In the adjacent "film metaphor" column, "each folder is viewed as a patrone of a film" (col. 13, lines 11-12). Appellants believe that a better translation might be "each folder is viewed as a film canister", which the outline of the file metaphor appears to illustrate. However, there is no disclosure

that the text shown within the outline of a film metaphor – for example, "flower - 10 May '98 - 25 sheets" – is used as the <u>folder name</u>. At least some of this information corresponds to values of certain fields of film data 30c, such as the "film name" field and the "date" field.

As can be understood with reference to Fig. 34, the Nakabayashi reference discloses that the graphical view of the film metaphor – e.g. "Karario at Matsumoto - 27 May 1998" – is produced in group display region dp3 on the screen display generated by the print processing operation of the main control section 60 of the image data processing software of Fig 3. Again, there is no disclosure that the text shown within the outline of a film metaphor is the <u>folder name</u> (col. 24, line 44 – col. 25, line 3). Instead, as can be understood with reference to the hierarchical folder structure of Fig. 47, the "film data 30c" (containing the textual information needed to draw the graphical view of the film metaphor) "are saved as a database file ai_dpe.db0 of a 'main' folder 31" (col. 35, lines 40-44). The contents of this database file can be accessed by the image data processing software for use in drawing the graphical view of the film metaphor on the print processing operation screen. The Nakabayashi reference further discloses:

> "in the case in which the image file 30a is to be saved on a hard disk 13b, it is saved in a <u>'films' folder 33</u> formed in the 'main' folder 31. One folder is further formed for each patrone in the 'films' folder 33. When 'swimming in the sea' is set as the name of the patrone, a <u>'swimming in the sea' folder 34</u> is obtained. When 'hiking' is set as the name of the patrone, a <u>'hiking' folder 35</u> is obtained. Database files ai_dpe. db1 and ai_dpe. db2 are created as the photographic data 30b in the respective folders and individual image files 30a are saved with unique names. As described earlier, the thumb nail data are saved in either of the two database files which has the extension of db2, and the residual photographic data are saved in the database file having the extension of db1. Moreover, information about only the image file 30a saved in the same directory is stored in the database file and so is the 'hiking' folder 35 as a matter of course. For the reasons of the processing, it is convenient that there is a patrone which saves temporarily inseparable data, and a patrone having the name of 'others' is prepared. The image file 30a classified for the patrone of 'others' is saved in the same column as the above-mentioned 'swimming in the sea' folder 34 and 'hiking' folder 35 which are provided under the 'films' folder 33."

Thus, with regard to folder names, the Nakabayashi reference teaches, arguendo and at most, that the folder name corresponds to the text of the "film name" field of film data 30c. The "date" field of film data 30c is a <u>different</u> field from the "film name" field.

It is also noted that the operation of the Nakabayashi reference can be disadvantageous

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relative to the operation recited in claim 11. In order to locate photos that are associated with a particular date, the Nakabayashi reference requires that the specialized image data processing software be utilized because the "date" information resides within the ai_dpe.db0 database file. This database file is arcanely named, and would it not be obvious to a user that the date information is contained therein. Furthermore, without the specialized image data processing software of the reference, there is no disclosure as to how a user would locate and obtain the date information within the file. According to Appellants' invention, however, the photos may be readily located by a user via navigating to the folder whose folder name is indicative of the date of interest.

Accordingly, the novel features of the present invention are not anticipated by the Nakabayashi reference in that the above-discussed essential elements, arranged as required by the claims and recited in as complete detail as in the claim, are absent from the reference. Therefore, the rejection of claim 11, and its dependent claims 12-14 and 16-25, is improper at least for that reason and should be overruled.

2. **The Nakabayashi reference does not disclose all the limitations of Appellants' independent claims 27, 35, 37, and 41 in that the limitation of a "folder name indicative of the date" is absent from the reference.**

Independent claims 27, 35, 37, and 41 each recite a similar "folder name indicative of the date" limitation as is recited in claim 11, and thus the rejection of these additional independent claims is traversed for similar reasons as argued above for claim 11. In rejecting claim 27, the Examiner contends that "as shown in fig 6, folders are indicative of date, month, and year of the save information, col. 13, lines 41-45" (Office Action, p.10). In response, Appellants disagree, and contend that, for similar reasons as explained heretofore, the folder name is not indicative of the date.

In rejecting claim 35, the Examiner contends that "image saved in the file folder has an association with date, month, and year as shown in fig 6" (Office Action, p.13). In response, Appellants disagree, and contend that, for similar reasons as explained heretofore, the claim does not recite an association of the file folder.

In rejecting claim 37, the Examiner contends that "the folder having a folder name indicative of the date col 12, lines 46-68, through col 13, lines 1-10" (Office Action, p.14). In response, Appellants disagree, and contend that, for similar reasons as explained heretofore, the folder name is not indicative of the date.

In rejecting claim 41, the Examiner contends that "main control section 60 of fig 3, initiates scanning unit 11a or camera 11b of fig 2 and image modification control section 40 of fig 3, to generates various parameters for automatically executing and storing an image processed in the system of fig 2, col. 13, lines 32-36, and col. 12, lines 23-28" (Office Action, p.15-16). In response, Appellants disagree, and contend that, to whatever extent, if any, the Examiner's stated position may be correct, the Nakabayashi reference does not disclose that the folder name is indicative of the date, for similar reasons as explained heretofore.

Accordingly, the novel features of the present invention are not anticipated by the Nakabayashi reference in that the above-discussed essential elements, arranged as required by the claims and recited in as complete detail as in the claim, are absent from the reference. Therefore, the rejection of independent claims 27, 35, 37, and 41, and dependent claims 28-34, is improper at least for that reason and should be overruled.

B. **Claim 15 was improperly rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. patent 7,113,306 to Nakabayashi ("Nakabayashi").**

1. The rejection of dependent claim 15 is improper for the same reasons that render the rejection of its base claim 11 improper.

"A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." (35 U.S.C. §112, paragraph 4.)

Claim 15 depends from base claim 11, which was rejected under 102(e) based on the Nakabayashi reference. Appellants have argued heretofore the reasons why the rejection of base claim 11 is improper. Because the rejection of base claim 11 is improper, the rejection of its dependent claim 15 is also improper for at least the same reasons.

2. The Nakabayashi reference does not disclose all the limitations of

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dependent claim 15 in that the limitation of "wherein the folder name is
indicative of a particular month and year" is absent from the reference.

Appellants further contend that dependent claim 15 was improperly rejected because the
single cited reference does not disclose all of the essential elements of the claim arranged as
required by the claim and in as complete detail as in the claim.

Dependent claim 15 recites:

"15. The method of claim 11, wherein the folder name is indicative of a particular
month and year." (emphasis added)

With regard to claim 15, the Examiner states "fig 5 and 6 shows folder associated with
date, month and year" (Office Action, p.7; emphasis added).

For similar reasons as explained heretofore with reference to claim 11, the
Nakabayashi reference discloses no folder names that are indicative of a particular month and
year. The only folder names disclosed in the reference are illustrated in Fig. 47: "main",
"removable", "films", "swimming in the sea", and "hiking". It is noted that none of these
folder names are indicative of a particular month and year.

Therefore, for this additional reason, the Nakabayashi reference does not disclose all
of the essential elements of the claim arranged as required by the claim and in as complete
detail as in the claim. Therefore, the Examiner has failed to establish a prima facie case of
anticipation at least on these grounds, and the rejection is improper at least for this reason and
should be overruled.

C. **Claims 1-3, 6-9, 36, and 38 were improperly rejected under 35 U.S.C. §102(e)
as being unpatentable over U.S. patent 7,113,306 to Nakabayashi
("Nakabayashi").**

Appellants contend that claims 1-3, 6-9, 36, and 38 were improperly rejected because
the single cited reference does not disclose all of the essential elements of the claims arranged
as required by the claims and in as complete detail as in the claims.

1. The Nakabayashi reference does not disclose all the limitations of the

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claims in that the limitations of configuring an optical scanning
arrangement with predefined settings for scanning parameters appropriate
to a photographic image and optically scanning the target item using the
predefined settings, wherein the settings are not predefined by the user,
are absent from the reference.

The rejection of independent claim 1, and its dependent claims 2-3 and 6-9, is
respectfully traversed for at least the following reasons. Claim 1 recites:

"1. A method of optically scanning a target item, comprising:
    configuring an optical scanning arrangement with predefined settings for scanning
parameters appropriate to a photographic image;
    initiating a scanning operation;
    in response to the initiating, optically scanning the target item using the predefined
settings to form a digital image of the target item; and
    converting the digital image into a data file, wherein the scanning and the converting
are performed automatically without intervention by a user, and wherein the predefined
settings are not defined by the user." (emphasis added)

The Examiner has not established a *prima facie* case of obviousness at least because the
applied references do not teach or suggest all of Appellants' claim limitations.

Appellants' invention, as recited in claim 1, configures an optical scanning
arrangement with predefined settings for scanning parameters. The predefined settings are
appropriate for scanning a photographic image, and are not defined by the user. The target
item (e.g. a photograph placed on the scanner glass) is then optically scanned using the
predefined settings. Thus the optical scanning arrangement of Appellants' claim 1 is
configured with the predefined parameter settings appropriate to a photographic image before
the target item is scanned, and the thus-configured scanning arrangement uses these
predefined parameters when scanning the target item. Claim 1 is directed to configuring the
scanning arrangement with predefined parameter settings prior to scanning the target item,
and then scanning the target item in conformance with those parameter settings in order to
produce a digital image data file.

Conversely, with regard to a scanned image, the Nakabayashi reference is directed to
post-processing the digital image data file after the target item has been scanned. The post-
processing is typically done in a manner such that the original digital image data file is

retained. "When display, output or print is actually required, various image processings are executed by referring to modification information on only a work area with original image data left. Therefore, it is possible to easily enjoy image modification or the like with the original image data left as they are" (Abstract). In operation, image data – for example, image data captured from scanner 11a (Fig. 2) – is stored in image data storage region A11 of data holding unit A1 in its original form (Fig. 1; col. 7, lines 37-49). Parameter setting unit A2 is used to set image processing parameters for particular image data; these parameters get stored in parameter storage region A12 of data holding unit A1. Then, image data to be post-processed, and the corresponding image processing parameters that define the post-processing, are retrieved from image data storage region A11 by data acquiring unit A4 (col. 8, lines 27-32). Finally, post-processing of the retrieved image data in accordance with the image processing parameters is performed by one or more modifying engines A31,A3n of image reproducing unit A3 (col. 8, lines 46-54).

With particular regard to the limitations of the configuring step of claim 1, the Examiner cites the parameter setting unit A2 and image modification section 40 of the image processing apparatus of Fig. 3 (Office Action, p.3., para. 1). However, the configuring step requires that the predefined parameters are for scanning parameters, and the optical scanning arrangement is configured with these scanning parameters. There is no disclosure in the reference that scanner 11a is ever configured with any parameters generated by parameter setting unit A2. Rather, as explained above, the parameters generated by parameter setting unit A2 are used by modifying engines A31,A3n of image reproducing unit A3 to modify image data that has been previously captured by scanner 11a and stored in image data storage region A11 of data holding unit A1. Thus the Nakabayashi reference fails to disclose the limitations of the configuring step.

With particular regard to the limitations of the scanning step of claim 1, the Examiner states that "main control section 60 of fig 3, initiates scanning unit 11a ... of fig 2 and image modification control section 40 of fig 3, to generates various parameters for automatically executing an image processing, col. 13, lines 32-36, and col. 12, lines 23-28" (Office Action, p.3, para 3). However, claim 1 recites optically scanning the target item using the predefined

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settings for scanning parameters appropriate to a photographic image with which the optical scanning arrangement has been configured. As argued above, there is no disclosure in the reference that scanner 11a is ever configured with any such parameters. Thus the Nakabayashi reference fails to disclose the limitations of the scanning step.

With further regard to the predefined settings, claim 1 recites that the predefined settings with which the scanning arrangement is configured are not defined by the user. According to the Nakabayashi reference:

"The parameter setting unit A2 serves to generate a parameter as a result, and includes the case in which an instruction for an image processing from a user through a GUI is accepted to set a parameter and the case in which image data are originally inspected to set a parameter for implementing an image processing to meet a predetermined purpose." (col. 8, lines 14-20; emphasis added)

Thus in the latter case, where the predefined settings for the scanning arrangement are not defined by the user, these predefined settings are determined instead by inspecting the captured image data. This is feasible to accomplish the purposes of the Nakabayashi reference because the image processing is performed as a post-processing operation after the image data has been captured. However, in claim 1, the predefined scanning parameter settings must be known (and then used to configure the scanning arrangement) before the image data has been captured, so that the scanning arrangement can be operated using those settings in order to capture that image data. Such would be clearly impossible in the Nakabayashi reference, since the predefined parameter settings could only be known after the image data has been captured. Thus the Nakabayashi reference fails to disclose the limitation that the predefined settings with which the scanning arrangement is configured are not defined by the user.

Independent claims 36 and 38 each recite similar limitations as claim 1, and were rejected for similar reasons as presented for claim 1. Therefore, the rejection of claims 36 and 38 is traversed for similar reasons as argued above for claim 1.

Accordingly, the novel features of the present invention are not anticipated by the Nakabayashi reference in that the above-discussed essential elements, arranged as required by the claims and recited in as complete detail as in the claim, are absent from the reference.

Therefore, the rejection of independent claims 1, 36, and 38, and dependent claims 2-3 and 6-9, is improper at least for these reasons and should be overruled.

D. Claim 4 was improperly rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. patent 7,113,306 to Nakabayashi ("Nakabayashi").

1. The rejection of dependent claim 4 is improper for the same reasons that render the rejection of its base claim 1 improper.

Claim 4 depends from base claim 1, which was rejected under 102(e) based on the Nakabayashi reference. Appellants have presented heretofore the reasons why the rejection of base claim 1 is improper. Because the rejection of base claim 1 is improper, the rejection of its dependent claim 4 is also improper for at least the same reasons.

2. The Nakabayashi reference does not disclose all the limitations of Appellants' dependent claim 4 in that the limitation of "storing the data file on the file system in a folder having a folder name indicative of the date" is absent from the reference.

Dependent claim 4 recites:

"4. The method of claim 3, further including specifying a date, and wherein the storing further includes storing the data file on the file system in a folder having a folder name indicative of the date." (emphasis added)

The failure of the Nakabayashi reference to disclose the limitation of "storing the data file on the file system in a folder having a folder name indicative of the date" has been discussed heretofore in considerable detail with regard to claim 11. Thus for similar reasons as have been explained for claim 11, the Nakabayashi reference fails to disclose all of the essential elements of claim 4 arranged as required by the claim and in as complete detail as in the claim. Accordingly, the Examiner has failed to establish a prima facie case of anticipation at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

E. Claim 5 was improperly rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. patent 7,113,306 to Nakabayashi ("Nakabayashi").

1. The rejection of dependent claim 5 is improper for the same reasons that render the rejection of its parent claim 4 improper.

Claim 5 depends from parent claim 4, which was rejected under 102(e) based on the Nakabayashi reference. Appellants have presented heretofore the reasons why the rejection of parent claim 4 is improper. Because the rejection of parent claim 4 is improper, the rejection of its dependent claim 5 is also improper for at least the same reasons.

2. The Nakabayashi reference does not disclose all the limitations of Appellants' dependent claim 5 in that the limitation of "wherein the folder name is indicative of a particular month and year" is absent from the reference.

Dependent claim 5 recites:

"5. The method of claim 4, wherein the folder name is indicative of a particular month and year." (emphasis added)

The failure of the Nakabayashi reference to disclose the limitation of "wherein the folder name is indicative of a particular month and year" has been discussed heretofore in considerable detail with regard to claim 15. Thus for similar reasons as have been explained for claim 15, the Nakabayashi reference fails to disclose all of the essential elements of claim 5 arranged as required by the claim and in as complete detail as in the claim. Accordingly, the Examiner has failed to establish a prima facie case of anticipation at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

VIII. CONCLUSION

Appellants contend that claims 1-9, 11-25, 27-38, and 41 were improperly rejected because the applied reference does not disclose all of Appellants' claim limitations. This reason distinguishes Appellants' claims from the cited reference, and renders Appellants'
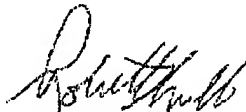
claims patentable in light of the cited reference.

Overruling of the Examiner's rejections of claims 1-9, 11-25, 27-38, and 41 is respectfully requested.

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AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

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IX. CLAIMS APPENDIX

1. A method of optically scanning a target item, comprising:

configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;

initiating a scanning operation;

in response to the initiating, optically scanning the target item using the predefined settings to form a digital image of the target item; and

converting the digital image into a data file, wherein the scanning and the converting are performed automatically without intervention by a user, and wherein the predefined settings are not defined by the user.

2. The method of claim 1, further including:

automatically storing the data file.

3. The method of claim 2, wherein the storing includes storing the data file on a file system.

4. The method of claim 3, further including specifying a date, and wherein the storing further includes storing the data file on the file system in a folder having a folder name indicative of the date.

5. The method of claim 4, wherein the folder name is indicative of a particular month and year.

6. The method of claim 1, wherein the scanning parameters are selected from the group consisting of pixel depth, resolution, crop mode, and skew correction mode.

7. The method of claim 6, wherein the scanning parameter settings appropriate to a photographic image includes:

pixel depth = 24-bit color;

resolution = 150 dots per inch;

crop mode = automatic border detection; and

skew correction mode = automatic image straightening.

8. The method of claim 4, wherein the file system has no folder having a folder name indicative of the date, further including:

creating the folder having the folder name indicative of the date.

9. The method of claim 4, wherein the data file is a plurality of data files and wherein the file system has a plurality of folders, further including:

viewing a representation of the plurality of folders; and

viewing a representation of the data files in one of the folders.

11. A method of automatically organizing digital images, comprising:

acquiring a digital image from an image source;

automatically associating a date with the digital image;

automatically converting the digital image into a data file; and

storing the data file into a folder of a file system, the folder having a folder name indicative of the date.

12. The method of claim 11, further including:

creating the folder if no other folder is associated with the date.

13. The method of claim 11, wherein the date is the capture date when the image was captured by the image source.

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14. The method of claim 11, wherein the date is the storage date when the image was converted into a data file.

15. The method of claim 11, wherein the folder name is indicative of a particular month and year.

16. The method of claim 11, wherein the folder is selected from a set of folders.

17. The method of claim 11, wherein the digital image is a previously captured image, and wherein the acquiring further includes:

uploading the previously captured image.

18. The method of claim 11, wherein the acquiring further includes:

predefining settings for image acquisition parameters appropriate to a photographic image; and

capturing the digital image with the image source according to the predefined settings.

19. The method of claim 11, further comprising:

performing a post-processing operation on the data file.

20. The method of claim 19, wherein the performing includes performing an image polishing operation.

21. The method of claim 19, wherein the performing includes processing the data file with an application program.

22. The method of claim 21, wherein the performing further includes sending the processed data file to a destination.

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23. The method of claim 22, wherein the destination is a peripheral device.

24. The method of claim 23, wherein the peripheral device is selected from the group consisting of a printer and a fax machine.

25. The method of claim 21, wherein the application program is selected from the group consisting of an image polishing application, a creative printing application, a photo album application, an e-mail application, and a photo web site upload application.

27. An image processing system, comprising:

at least one image source, each image source for providing at least one digital image upon request;

an image capture subsystem coupled to the at least one image source for requesting and receiving the at least one digital image from the at least one image source, the image capture subsystem further for associating a date with each digital image and automatically converting each digital image into a corresponding image file; and

a file system coupled to the image capture subsystem for automatically storing each image file in a selected one of a plurality of data folders, the selected data folder having a folder name indicative of the date.

28. The image processing system of claim 27, comprising:

an image management subsystem coupled to the image capture subsystem and the file system for viewing the plurality of data folders and the image files in a specified data folder.

29. The image processing system of claim 28, comprising:

a post-processing subsystem coupled to the image management subsystem for post-processing at least one selected one of the image files.

30. The image processing system of claim 29, wherein the post-processing subsystem

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is further coupled to the file system for accessing the selected ones of the image files.

31. The image processing system of claim 29, comprising:

an image destination coupled to the post-processing subsystem for receiving output data corresponding to at least one selected one of the image files.

32. The image processing system of claim 27, wherein the date is an image acquisition date provided by the image source.

33. The image processing system of claim 27, wherein the date is a current date provided by a date subsystem coupled to the image capture subsystem.

34. The image processing system of claim 27, wherein the at least one image source is an optical scanner, and wherein the image capture subsystem provides predefined settings appropriate to a photographic image to the optical scanner for use in providing the at least one digital image.

35. A processor-readable medium having processor-executable instructions thereon which, when executed by a processor, cause the processor to:

acquire a digital image from an image source;

automatically convert the digital image into a data file having a date associated with the digital image; and

store the data file into a data folder of a file system, the folder having a folder name indicative of the date.

36. A processor-readable medium having processor-executable instructions thereon which, when executed by a processor, cause the processor to:

configure an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;

detect an initiation of a scanning operation;

in response to the initiation, optically scan the target item using the predefined settings to form a digital image of the target item; and

convert the digital image into a data file, wherein the instructions to scan and convert are performed automatically after the initiation without intervention by a user, and wherein the predefined settings are not defined by the user.

37. An image processing system, comprising:

means for acquiring a digital image from an image source;

means for automatically converting the digital image into a data file having a date associated with the digital image; and

means for storing the data file into a data folder of a file system, the folder having a folder name indicative of the date.

38. An image processing system, comprising:

means for configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;

means for initiating a scanning operation;

means for optically scanning the target item using the predefined settings to form a digital image of the target item; and

means for converting the digital image into a data file, wherein the scanning and the converting are performed automatically without intervention by a user, and wherein the predefined settings are not defined by the user.

41. An image processing system, comprising:

at least one image source, each image source for providing at least one digital image upon request;

an image capture subsystem coupled to the at least one image source which requests and receives the at least one digital image from the at least one image source, associates a

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date with each image, and automatically converts each image into a corresponding image file; and

     a file system coupled to the image capture subsystem which receives each image file from the image capture subsystem and automatically stores each image file in a selected one of a plurality of data folders, the selected data folder having a folder name indicative of the date.

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X. EVIDENCE APPENDIX

None

IIP Docket No. 10019417-1

XI. RELATED PROCEEDINGS APPENDIX

None